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10/588,041	08/01/2006	Bogdan Moraru	HUBR-1298	3661
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FULBRIGHT & JAWORSKI, LLP				
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NEW YORK, NY 10103-3198				
EXAMINER				
MESH, GENNADIY				
ART UNIT		PAPER NUMBER		
1796				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

nyipdocket@fulbright.com

Office Action Summary

Application No.

10/588,041

Applicant(s)

MORARU ET AL.

Examiner

GENNADIY MESH

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/200)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

DETAILED ACTION

1.1. Applicant's Amendment filed on July 19, 2010 is acknowledged.

Claims 1-19 have been canceled by Applicant. Claims 20 - 39 are active.

No amendments to claims have been presented with this Amendment.

1.2. Rejection is maintained as it was set forth in preceding Office action mailed on January 19, 2010. Therefore, it is proper to make this action Final.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

2. Claims 20-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Albrecht et al. (WO 00/77058 - note that US 6,777,517 as equivalent of WO 00/77058 will be used in rejection as a English translation) in view of Hirata et al. (US 5,912,284).

Regarding claims 20-39 Albrecht discloses copolymers based on unsaturated mono-or dicarboxylic acid derivatives and oxyalkylene glycol alkenyl ethers, method of production and use of copolymers as functional additives in cement based formulations (see abstract, column 1, lines 5-35 and claims 1-20).

Note, that copolymers disclosed by Albrecht comprising substantially same structural units as it claims by Applicant in Claim 20:

i) from 51 to 95 mol % of structural units (Ia) or (Ib) or (Ic) - see column 2, lines 43 - 65 - this unit is identical to unit a) claimed by Applicant

ii) from 1 to 48.9 mol % of the unit represent by structural formula II - see column 3, lines 10 -24 - this unit has substantially same chemical structure as comprising polyethylene glycol moiety, but different molecular weight or degree of polymerization n from 0 to 200 of ethylene oxide groups compare with degree of polymerization from 250 to 500 in unit b) claimed by Applicant in Claim 1.

iii) from 0.1 to 5 mol% of identical units IIIa or IIIb - see column 3, lines 25 - 55.

Thus, the difference between copolymer claimed by Applicant and copolymer disclosed by Albrecht is that polyalkylene oxide in side chain (see compound of formula II) has higher degree of polymerization.

However, Hirata teach, that copolymer of similar chemical structure, comprising polyalkylene oxide moiety with degree of polymerization up to 300 in side chain (see general formula (3), column 2, lines 49 - 68 and column 3, lines 1-3) useful as cement admixture (see column 1, lines 5-16) and could give cement composition properties of achieving a high water reducing rate and preventing a reduction in the obtained

flowability (called "slump loss"). Hirata also pointed out (see column 5, lines 33 - 40) that in order to obtain high water reducing capability, it is important to disperse cement particles with steric repulsion and hydrophilicity due to a polyalkylene glycol chain having an average addition number of moles of oxyalkylene groups contained in the repeating unit (I') of 1 to 300. Therefore, it is preferred that a large number of oxyethylene groups be introduced into the polyalkylene glycol chain and a polyethylene glycol chain is the most preferred".

Therefore, it would be obvious to one of ordinary skill to modify copolymer disclosed by Albrecht by incorporating polyalkylene oxide with degree of polymerization up to 300 per teaching of Hirata.

Regarding Claim 22 see Albrecht column 11, line 1.

Regarding Claims 23 and 24 see Albrecht column 3, lines 1-10.

Regarding Claims 27-30 see Albrecht column 7, line 42-56.

Regarding Claims 31-39 Albrecht discloses (see column 11, lines 22- 35) process of preparation of the copolymer by free radical polymerization, with out a solvent or in aqueous solution, at temperature in a range from 20⁰ C to 100⁰ C, wherein polymer can be present in concentration from 30 to 50 wt%.

Double Patenting

3.1 Claims 20-39 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,777,517 in view of Hirata et. al. (US 5,912,284).

As it was discussed above claimed subject matter of instant Application is substantially same as claimed subject matter of US Pat. 6,777,517 - the difference in degree of polymerization of polyalkylene oxide in side chain (see unit b of formula II). However, Hirata that polyalkylene oxide with high degree polymerization (n value up to 300) is beneficial in order to obtain high water reducing capability, it is important to disperse cement particles with steric repulsion and hydrophilicity due to a polyalkylene glycol chain having an average addition number of moles of oxyalkylene groups contained in the repeating unit (I') of 1 to 300. Therefore, it is preferred that a large number of oxyethylene groups be introduced into the polyalkylene glycol chain and a polyethylene glycol chain is the most preferred".

Therefore, it would be obvious to one of ordinary skill to modify copolymer claimed by Albrecht by incorporating polyalkylene oxide with degree of polymerization up to 300 per teaching of Hirata.

For this reason, claimed subject matter of instant application is obvious modification of claimed subject matter of US Pat. 6,777,517 in view of Hirata et al. (US 5,912,284).

3.2. Claims 20-39 are directed to an invention not patentably distinct from claim 1-20 of commonly assigned US Pat. 6,777,517 as it was discussed above (see paragraph 3.1.).

3.3. The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP

Chapter 2300). Commonly assigned US Pat. No. 6,777,517, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

3.4. Claims 20 -39 are rejected under 35 U.S.C. 103(a) as being obvious over US Pat. 6,777,517 in view of Hirata et al. (US 5,912,284) as it was explained above (see paragraph 2 above).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject

matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).

Response to Arguments

4. Applicant's arguments filed July 19, 2010 have been fully considered but they are not persuasive.
5. Applicant's arguments related to Claims 20-39 rejected under 35 U.S.C. 103(a) as being unpatentable over Albrecht et al. in view of Hirata et al. and to Claims 20 - 39 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,777,517 in view of Hirata et al. based on following statement:

"an object of the present invention is based on improving early strength development. This is achieved by the provision of the inventive compositions.

The fact that an improved early strength due to the longer side chains can be attained cannot be gathered from the teachings of Hirata, as Hirata only describes that water reduction increases the final strength of concrete. ...

In view of the foregoing, one of skill in the art would not have looked to the teachings of Hirata to solve the problem that was the objective of the present application, as described above. Thus, all obviousness rejections should be withdrawn.

For the same reasons, it is believed the obviousness-type double patenting rejection of claims 20-39 over the '517 patent in view of Hirata should be withdrawn. "

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "improving early strength of development") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In addition note, that Albrecht combined with Hirata discloses all elements of Applicant's invention as specific composition. Therefore, as substantially same, this composition has substantially same properties, including "improving early strength of development".

For reasons above, Applicant's arguments were found unpersuasive. Therefore, all rejections of Record are maintained.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GENNADIY MESH whose telephone number is (571)272-2901. The examiner can normally be reached on 10 a.m - 6 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (571) 272 1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Milton I. Cano/
Supervisory Patent Examiner, Art Unit 1796

/GM/

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